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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/116,425      | 07/15/1998  | ROBERT J. PIECHOWIAK | M-2760-3P           | 2543             |

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EXAMINER

CHERUBIN, YVESTE GILBERTE

ART UNIT PAPER NUMBER

3713

DATE MAILED: 03/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/116,425

Applicant(s)

PIECHOWIAK ET AL.

Examiner

Yveste G. Cherubin

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on February 14, 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

1. This office action is in response to the RCE of the application filed on February 14, 2002 in which claims 1, 4, 7-16 are amended and claim 5 is canceled.
2. Two versions of office action are being submitted in this response.

### Version I

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marnell II (US Patent 5,393,057) in view of Manship (US Patent No. 5,393,061).

As per claims 1-4, 6, Marnell II discloses a slot gaming apparatus comprising a primary game such as poker and a secondary game such as bingo. Marnell further discloses an electronic machine that has the ability to generate a first game result pursuant to a first game, by displaying a combination of symbols (28, 29) randomly selected from a first set of symbols, using circuitry within said slot machine and displaying the first game result on a video screen (28) of said slot machine. Upon the occurrence of winning hands in the primary game, or when the first game result meets a certain criteria, players receive an award and a

secondary or bonus game is generated, 6:14-27 and upon winning the secondary game or bonus, players will be granted an additional award, see 6:14-27. Marnell's secondary or bonus game, being the bingo type game, meets the limitations of the bonus game being other than a random selection of symbols so as not to be a version of the first game, said bonus game generating and displaying a result using the circuitry of the said slot machine. Upon winning the primary game, players will receive an award and upon winning the secondary game or bonus, players will be granted an additional award, see 6:14-27. However, Marnell's does not disclose the first game result and the bonus game result being performed by the same hardware. Manship discloses a video slot machine capable of displaying a primary game and a "fever mode" or secondary game or bonus game using the same hardware circuitry and wherein the primary game results display the regular bells. Upon the occurrence of the primary game result, the "fever mode" or a bonus mode result displays the colored enlarged bells, which are another variation or version of the bells of the primary game. It would have been obvious at the time of the invention to use one display in the Marnell's device as taught in the Manship type device in order to avoid additional hardware and therefore reduce the hardware financial cost. As per claims 7, 8, 12, 13, in reference to Fig. 1, Marnell discloses the first set of symbols in his primary game representing playing cards (29) on a video display (28), . As per claims 9-11, 14-16, in reference to Fig. 1, Marnell discloses his bonus game results comprising indicia that fills a grid pattern (51) such as a bingo type game

and wherein said bonus game results comprising letters, numbers as shown (see elements 53), 5:22-36.

## **Version II**

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Manship et al. (US Patent No. 5,393,061).

Manship discloses a video slot gaming machine wherein a primary game is played and upon the winning result of the primary game, such as the display of the bells in the center row and the center column, a “fever mode” or bonus mode is generated, displaying another version or variation of the bells (colored enlarged bells) using the same hardware circuitry of the said video screen. Manship further discloses granting payout for the winning result of the primary game and granting additional award for the winning result of the “fever or bonus” mode, 7:10-35.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manship (US Patent No. 5,393,061) in view of Marnell, II (US Patent No. 5,393,057).

As per claims 7-16, Manship discloses the claimed invention as substantially as shown above. However, Manship does not disclose the first set of symbols representing playing cards, and the bonus game result comprising indicia such as letters, numbers that fill a grid pattern. In reference to Fig. 1, Marnell discloses the first set of symbols in his primary game representing playing cards (29) on a video display (28), and his bonus game results comprising indicia that fills a grid pattern (51) such as a bingo type game and wherein said bonus game results comprising letters, numbers as shown (see elements 53), 5:22-36. It would have been obvious at the time of the invention to include the different types of indicia of Marnell into the Manship type device in order to offer more than one type of game to players and therefore make the game more appealing.

#### ***Response to Arguments***

6. Applicant's arguments filed on February 14, 2002 have been fully considered but they are not persuasive. The added limitations to claims 1, 4, 7 are still met by the cited references to Marnell and Manship. See rejection above.

#### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yveste G. Cherubin whose telephone number is (703) 306-3027. The examiner can normally be reached on 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (703) 308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

March 24, 2002

ygc



VALENCIA MARTIN-WALLACE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700

**Attachment for PTO-948 (Rev. 03/01, or earlier)**  
**6/18/01**

**The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.**

**INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

**1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

**2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

**Failure to take corrective action within the set period will result in ABANDONMENT of the application.**